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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91177192
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

NAUTICA APPAREL, INC.,

Opposer,

v.

MARTANNA LLC,

Applicant.

Opp. No. 91177192

Mark: GET NAUTI

Serial No. 78610037

OPPOSER'S TRIAL BRIEF

On the Brief

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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NAUTICA APPAREL, INC.,	Opp. No. 91177192
Opposer,	Mark: GET NAUTI
v.	Serial No. 78610037
MARTANNA LLC,	
Applicant.	

TO THE HONORABLE BOARD:

Opposer, Nautica Apparel, Inc. (hereinafter “Nautica”), through its undersigned attorneys, Baker and Rannells, PA, respectfully requests that its opposition to application Serial No. 78/610037 for the mark “GET NAUTI” owned by Martanna LLC (hereinafter “Martanna” or “Applicant”) be granted on the basis of likelihood of confusion and/or likelihood of dilution.

I. PROCEDURAL HISTORY / EVIDENCE OF RECORD

A. Procedural History

The Notice of Opposition was filed on May 1, 2007. Applicant filed its Answer and Affirmative Defenses on June 18, 2007.

On June 21, 2007 Nautica filed a motion to strike paragraph 5 of Applicant’s Answer and to strike Applicant’s affirmative defenses 1-5 and 13-18. Nautica’s motion was granted by (1) Applicant withdrawing its affirmative defenses 2-5 and 13, and amending paragraph 5 of their Answer, and (2) the Board, pursuant to its Order dated 9/20/07, striking the remainder of the

affirmative defenses (i.e., nos. 1 and 14-18) except that with regard to Applicant's 1st Affirmative Defense, (failure to state a claim), the motion to strike was denied with respect to Opposer's Sec. 2(a) claim, but otherwise granted.

Thereafter, the parties filed cross-motions for summary judgment, both of which were denied.

B. Nautica's Evidence of Record:

Nautica filed the following as evidence which is of record:

1. Testimony Deposition of Margaret M. Bizzari (referred to herein as "Test. Bizzari"), taken November 19, 2008, with the following exhibits:

Exhibits on Direct:

- A. Notice of Deposition of Bizazari.
- B. Various Class 25 and Class 3 U.S. Trademark registrations owned by Opposer.
- C. Excerpts from product color boards/look books for various years
- D. Store photos and store-within-a-store photos displaying NAUTICA and NAUTICAKIDS marks
- E. Product color boards for various years
- F. Photographs of various fragrance lines of Opposer
- G. Various product catalogues of Opposer.
- H. TV network and print media ads reports and Look Book reports
- I. Opposer sponsorship materials.
- J. Summaries – Opposer's U.S. annual wholesale sales (2001-2007) and annual advertising/promotional expenditures (2000-2007).

Exhibits on Cross:

- A-1. The Notice of Opposition in this proceeding
- A-2. USPTO TARR abstracts for Nautica's Reg. No. 1802504 (NAUTEX) and Nautica's Reg. No. 2697078 (NAUTEX).
- A-3. USPTO TARR abstract for Nautica's Reg. No. 3445949 (NAUTICARE)
- A-4. USPTO TARR abstract for Nautica's Reg. No. 1613918 (NAUTICA and sail design)
- A-5. Computer downloads of Google searches. (See Nautica's accompanying Objection and Motion to strike).

2. Nautica's 1st Notice of Reliance: Forty-five certified status and title copies of U.S. trademark and/or service mark registrations owned by Nautica (i.e., registrations in addition to those class 25 and class 3 registrations comprising Exhibit "B" to the Bizzari testimony deposition).

3. Nautica's 2nd through 23rd Notices of Reliance: Representative third party articles (Nexis) from each year from 1987 through and including April 2008 referencing Nautica and/or Nautica's NAUTICA marks.

4. Nautica's 24th Notice of Reliance: Decisions from legal proceedings instituted by Nautica in policing its mark.

C. Applicant's Evidence of Record:

The Applicant did not take any testimony depositions, but filed three Notices of Reliance, namely:

1. Applicant's 1st Notice of Reliance: A dictionary excerpt concerning the term "get."

2. Applicant's 2nd Notice of Reliance: Excerpts from application file of Ser. No. 78/885472 (Reg. No. 3233030) for the mark NAUTICA owned by Nautica, concerning a statement as to the English translation of "nautica."

3. Applicant's 3rd Notice of Reliance (See motion to strike filed concurrently herewith): Excerpts from three (3) third party articles from August 2008, two of which make a single reference to a book allegedly titled "*Nauti Dreams*" and one article that makes a reference to books allegedly titled "*Nauti Nights*" and "*Nauti Boy*" by author Lora Leigh.

II. FACTUAL BACKGROUND

Opposer, its History, Goods, and Reputation

Nautica, through its predecessors, began use of the NAUTICA brand and trademark in 1983 and its use has been continuous to the present.¹ As a result of Nautica's remarkable and enviable success, it has become one of the largest and best-known apparel companies in the United States and the world. Over the past seven (7) years, its U.S. wholesale sales have averaged over \$900 million/year.² The retail value being approximately double the aforementioned wholesale figures (i.e., approximately \$1.8 billion/year)³. In fact, according to NPD Marketing Research, from 2004-2007 Nautica had the second largest U.S. market share in the menswear category.⁴

The NAUTICA brand has developed and evolved into what is commonly referred to as a "lifestyle brand" that extends across a broad range of consumer products used by people in their day-to-day lives, including without limitation, clothing, fragrances and cosmetics, eyewear, watches, jewelry, luggage, handbags, furniture, bedding, fabrics and linens, housewares, tableware, etc.⁵

Nautica's products are offered for sale and sold throughout the entire United States in department stores, specialty stores, Nautica's own stores which operate under the NAUTICA mark (of which there are 115) and which also operate under the NAUTICAKIDS mark (of which there are 6)⁶, and over the Internet via Nautica's own websites, its licensees' websites, unrelated websites such as amazon.com, and authorized customer and portal websites. Examples of stores where Nautica products are offered for sale and sold are Macy's, Dillard's, Bloomingdale's,

¹ Test. Bizzari pp. 7-8

² Test. Bizzari pp. 50-51 and Ex. J thereto (Annual wholesale sales figures)

³ Test. Bizzari p. 51.

⁴ Test. Bizzari p. 51-52.

⁵ Test. Bizzari pp. 8-14.

⁶ Test. Bizzari, p. 29.

Belks, Lord & Taylor, Bed, Bath & Beyond, etc.⁷ In total, Nautica products are promoted and offered for sale in over 2,400 stores (not owned by Nautica) in the United States⁸. Because of the reputation and fame of Nautica, many well-known department stores have agreed to showcase Nautica and its products within designated department areas, known as a “store-within-a-store”. These “store-within-a-store” areas are exclusive Nautica space and exclusively include Nautica’s signage, images and trademarks.⁹

Nautica owns numerous U.S. trademark registrations in numerous classes, that contain the word mark NAUTICA or the prefix NAUT (hereinafter sometimes referred to collectively as the “NAUTICA Marks”), including eight (8) incontestable registrations of record in Class 25 and three (3) incontestable registrations in Class 3, the same classes of goods which have been applied for by Applicant.¹⁰

Nautica’s U.S. advertising and promotional expenditures over the past eight years have averaged in excess of \$37 million per year¹¹.

Nautica’s products, are advertised and promoted through print media including well known national and international publications such as *Cosmopolitan*, *Vogue*, *Elle*, “O” (*Oprah*), *Sports Illustrated*, *House & Garden*, *Fortune*, *GQ*, *Harper’s Bazaar*, *New York Time Magazine*, *Rolling Stone*, etc., with circulations averaging over 200 million per year and generating over a billion consumer impressions a year.¹²

Nautica products are also advertised and promoted on national broadcast television, including major networks such as CBS, FOX, NBC, ABC, Comcast, My Network, and CW

⁷ Test. Bizzari, pp. 26 and 81.

⁸ Test. Bizzari, p. 28.

⁹ Test. Bizzari, pp. 27-30; and Ex. “J” thereto (photographic examples).

¹⁰ Test. Bizzari, pp. 15-17 and Ex. “B” thereto; and Opposer’s 1st Notice of Reliance.

¹¹ Test. Bizzari, pp. 50-51 and 54-55, and Ex. “J” thereto.

¹² Test. Bizzari, pp. 39-40 and 42, and Ex. “H” thereto.

Affiliates during shows such well-known shows as *48 Hours*, *60 Minutes*, *the Tony Awards*, *Without a Trace*, *Everybody Loves Raymond*, *According to Jim*, *Friends*, *Jeopardy*, *Wheel of Fortune*, *Grey's Anatomy*, *Nightline*, *Ugly Betty*, *The Daily Show with Jon Stewart*, *Comedy Central*, and *House*¹³.

Nautica also promotes itself and its products through sponsorship of various sporting events, music events, charitable events, and the like, including, *inter alia*, the “Nautica Malibu Triathlon,” the “Subaru Gorge Games,” the “Legg Mason Tennis Classic,” the “Starlight Foundation,” the “AVP” volley ball tour, the “Newport Jazz Festival,” the “US Sailing Team,” numerous regattas, the “Nautica/GQ kayak for a Cause,” the “NYC Triathlon,” and many others¹⁴. Sponsored athletes wear Nautica clothing, sail boats/kayaks say “NAUTICA,” the sails say “NAUTICA,” the event tents, flags and signage say “NAUTICA,” and promotional goods (e.g., t-shirts) and samples (e.g., fragrance) say “NAUTICA.”¹⁵ The aforementioned promotional activities also generate multiple billions of consumer impressions. By way of example the 2006 AVP sponsorship garnered 1.6 billion impressions alone.¹⁶

III. ARGUMENT (LIKELIHOOD OF CONFUSION)

This is a case involving marks that share the root term NAUTI used on and in association with legally identical goods in classes 3 and 25 (i.e., the classes/goods in issue). The channels of trade and ultimate consumer are legally identical. As demonstrated below, confusion is likely, thereby irreparably damaging Nautica.

A. Nautica Has Priority

¹³ Test. Bizzari, pp. 38-44, and Ex. “H” thereto

¹⁴ Test. Bizzari, pp. 44-50, and Ex. “T” thereto.

¹⁵ Test. Bizzari, pp. 44-46.

¹⁶ Test. Bizzari, pp. 48-49 and Ex. “H” thereto.

Priority is not an issue in this proceeding. Applicant filed its “intent to use” application to register “GET NAUTI” on goods in Class 3 and Class 25 on April 15, 2005. There is no evidence of record that Applicant has ever used its mark. Nautica has proven ownership of a number of incontestable registrations for NAUTICA in Classes 3 and 25, registered long-prior to the filing of the ITU application in issue, thus making priority of use of Nautica’s Marks a moot point. See *Oxford Pendaflex Corp. v. Anixter Bros. Inc.*, 201 USPQ 851, 853 (TTAB 1978) (“priority is not a factor in an opposition proceeding wherein opposer has established ownership of [an] existing registration for the mark on which it relies in support of its claim of damage”); and *Black & Decker Mfg. Co., v. Bright Star Industries*, 220 USPQ 891 (TTAB 1983). Further, Nautica has been selling goods bearing the famous NAUTICA Marks for over 25 years. Nautica has priority as a matter of law.

**B. Analysis Of The DuPont Factors
Demonstrates That Confusion Is Likely
To Result From The Simultaneous Use
By The Parties Of Their Respective Marks**

In *In re E.I. duPont de Nemours & Co.*, 177 USPQ 563, 567 (CCPA 1973), the CCPA established a decisional process for determining likelihood of confusion in trademark cases. Thirteen (13) factors were propounded, each of which must to be considered when there is sufficient evidence of record and where the same are relevant. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 946 (Fed. Cir. 2000). Any one or more of the factors may control a particular case. See *In re Dixie Restaurants Inc.*, 41 USPQ2d 1531, 1533 (CAFC 1997).

Traditionally the primary factors are similarity of the marks, similarity of the goods or services, and fame of the opposer’s mark. With regard to “fame,” the fame factor “plays as

dominant role in cases featuring a famous or strong mark.” *See, Kenner Parker Toys Inc. v. Rose Arts Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

In this case the primary, controlling factors of record are (1) Nautica’s NAUTICA Marks and name are well-known and famous; (2) the dominant portion of the parties’ respective marks are very similar; (3) the parties’ respective goods recited in the application in issue and in Nautica’s registrations (and as used by Nautica) are almost entirely identical; and (4) for purposes of this proceeding, the parties’ respective goods are presumed sold to and through the same channels of trade, and to the same potential customers for such goods.

These primary factors, as well as the remaining relevant factors of record favor Opposer to such a degree that there must be a finding of likelihood of confusion.

**1st duPont Factor. The Similarity or Dissimilarity Of The Marks
In Their Entireties as To Appearance, Sound,
Connotation and Commercial Impression.**

A. Nautica’s Marks

Nautica is the owner of the mark and name NAUTICA and variations thereof, including the following registered and pending marks in Class 25 and Class 3¹⁷:

Class 25

Various NAUTICA registrations (e.g., 1862585, 1580007, and 1464663), and also:
NAUTICA and design (1523565)
NAUTICA NAVY (78713715)
NAUTICA ISLAND (78912365)
NAUTICAKIDS (3168753)
NAUTICA COMPETITION (3076796)
NAUTICA GOLF (3272760)
NAUTICA BEACH (3109967)
NAUTICA BLUE (2987139, 2993023)
NAUTICA OPTIONS (77081234)
NAUTICARE (3445949)
NAUTEX (2697078)

¹⁷ See Exhibit “B” to the Test. Bizzari and Opposer’s 1st Notice of Reliance.

NAUTICA JEANS (2474154)
NAUTICA JEANS COMPANY (2523102)
NAUTICA and sail boat design (1613918)

Class 3

Various NAUTICA registrations (1557528 and 1882757), and also:
NAUTICA OCEAN (77444030)
NAUTICA OCEANS (77444022)
NAUTICA BERMUDA BLUE (3447065)
NAUTICA VOYAGE (3170094)
NAUTICA BLUE (3170055)
NAUTICA COMPETITION (3076597)
NAUTICA and sail boat design (1557527)

Nautica, being a life-style brand, is also the owner of numerous use based NAUTICA registrations in classes other than Class 3 and Class 25, namely registrations in Classes 6, 8, 9, 11, 12, 14, 16, 18, 20, 21, 24, 26, 28, 35, 36, and 41¹⁸. Nautica has also used numerous other (non-registered) variations of its famous NAUTICA mark including, without limitation, the following which show the manner in which other variations have been used from time-to-time on clothing¹⁹:



NJC NAUTI /// JEANS COMPANY
Holiday 2003



NAU TICA JEANS
Holiday 2004

¹⁸ See Opposer's 1st Notice of Reliance.

¹⁹ See Test. Bizzari, pp. 17-24 and Ex. "C" to the Bizzari testimony.



NAU TICA JEANS
Holiday 2004



NAU TICA JEANS
Holiday 2004



NAU TIC AJE ANS
Holiday 2004



Nautica jeans company
N-2
Spring 2007



NAU- TICA // JNS CO
Summer 2008



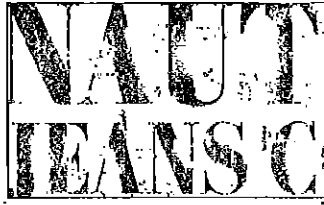
NAU TICA. EANS CO
Holiday 2008



N.A.U.T.I C^A JNS
Fall 2008



NAU. TI. CA
Holiday 2008



NAUT JEANS C
Denim Waist Patch for
Fall 2009

Also, note the following variation (i.e., BE NAUTI on boxer shorts fly) used by Opposer in the Spring of 2007²⁰:



The above are natural variant expressions of Nautica's marks that have appeared from time-to-time in the natural course of marketing and commercialization of Nautica's goods.

²⁰ See Test. Bizzari, pp. 20-21 and exhibit "C" to Bizzari testimony.

Additional variants will undoubtedly appear in the future as part of the natural course of marketing and commercialization of Nautica's goods.

Some of Nautica's mark variations are used to identify Nautica as the source of certain Nautica product lines (e.g., easy care products which bear the NAUTICARE mark²¹; NAUTEX brand "performance garments" manufactured with Nautica's proprietary NAUTEX fabric²²; and Nautica's children's line which bears the NAUTICAKIDS mark and/or the marks NAUTICA BOYS or NAUTICA GIRLS).²³

B. Applicant's Mark

Applicant's mark is "GET NAUTI" for a wide variety of men's, women's and children's clothing in Class 25 and fragrance and cosmetic type goods in class 3, most of which are legally identical to goods sold by Nautica under the NAUTICA marks.

The term "get", in Applicant's mark, is capable of more than one meaning. The primary meanings of the word are (1) in its transitive form: "obtain" or "come into possession of", and (2) in its intransitive form: "to become" or "grow to be."

See, The American Heritage® Dictionary of the English Language, (Fourth Edition) (Updated 2003), Houghton Mifflin Company:

get

v.tr.: 1. **a.** To come into possession or use of; receive; **b.** To meet with or incur. 2. **a.** To go after and obtain; **b.** To go after and bring; **c.** To purchase; buy. 3. **a.** To acquire as a result of action or effort; **b.** To earn; **c.** To accomplish or attain as a result of military action.

v.intr.: 1. **a.** To become or grow to be; **b.** To be successful in coming or going. 2. To be able or permitted. 3. **a.** To be successful in becoming; **b.** Used with the past participle of transitive verbs as a passive voice auxiliary; **c.** To become drawn in, entangled, or involved.

²¹ Test. Bizzari, pp. 69-71.

²² Test. Bizzari p.

²³ Test. Bizzari, pp. 66, 20, 127.

See, also, Collins Essential English Dictionary (2nd Edition 2006), HarperCollins Publishers:

get

1. to come into possession of; 2. to bring or fetch; 3. to catch (an illness); 4. to become; 5. to cause to be done or to happen; 6. to hear or understand; 7. to reach (a place or point); 8. to catch (a bus or train); 9. to persuade.

With “get” used in its transitive form, Applicant’s mark means to come into possession of or to obtain NAUTI (brand clothing or fragrances/cosmetics).

With “get” used in its intransitive form, Applicant’s mark means to become or to grow to be NAUTI, which could mean either that one would somehow become associated with a consumer’s impression of NAUTI (e.g., things of the water/things nautical, or Opposer, Nautica), or it could be a play on the word “naughty.” Regarding the first meaning, and given Nautica’s use of variations of its mark and use of variations of its mark for particular product lines, and given Nautica’s market presence as a “lifestyle brand,” GET NAUTI may be perceived as a NAUTICA variant and as a way to associate oneself with the NAUTICA brand and lifestyle. As stated by Ms. Bizzari in her testimony, at pp. 9-12:

A lifestyle brand is a brand that receives notoriety, and once it receives notoriety, it is very likely to expand out into other areas. . . . The main effort of a company . . . when they seek to become a lifestyle brand . . . what they want is for someone to become, their whole life is surrounded by Nautica products. You know, they sleep on Nautica sheets, they wear Nautica fragrances, they wear Nautica clothes, they wear Nautica shoes, their furniture comes from Nautica, their watches, their eye wear, their whole lifestyle is geared around the Nautica brand.

The Applicant’s position thus far in this proceeding is that the meaning and commercial impression of its mark is a play on the word “naughty” exclusive of any other meaning or commercial impression. As evidenced by the above dictionary definitions, Applicant’s position

is untenable. In fact, consumers may, at any one time, perceive any one or all of the meanings and commercial impressions associated with the mark GET NAUTI. The exclusive meaning urged by Applicant simply cannot hold up - it is presumed that Applicant does not intend to advertise, promote and sell skimpy, “naughty” bikinis to children²⁴.

If Applicant truly desired that “naughty” was to be its sole and exclusive meaning, Applicant would have chosen the mark GET NAUGHTY. Applicant made a conscious decision not to. Applicant did not apply for the mark “Get Naughty,” and purposefully and intentionally did not use the term “naughty.” Instead, it choose the term “Nauti,” a term associated even in its truncated form with things nautical. (The term “naut” is an abbreviation for the term “nautical.” See, e.g., *Merriam-Webster* Online dictionary, *MSN Encarta* dictionary, and *Dictionary.com Unabridged* (v 1.1). The meaning of the root “naut” and/or “nauti” is of things nautical). There can be no valid argument to the contrary. In that regard, it is no accident that various of the goods recited in the application in issue concern the beach, water, boating and the like (e.g., sunscreen cream and sunblock preparations, beach footwear, swimwear, bathing trunks, bathing caps, beach wraps, bikinis, and bathing suits).

Obviously, Applicant’s adoption of the term “NAUTI” (rather than “naughty”) makes the similarity of Applicant’s mark and Nautica’s NAUTICA Marks similar in sight, sound, meaning and commercial impression. The spelling of its mark as “NAUTI” dispels Applicant’s argument concerning the sole meaning it has urged throughout this proceeding. Applicant adopted the term “NAUTI.” The Applicant intended for the consumer to view the mark as “NAUTI” – a term identical to NAUTICA except for the last two letters.

²⁴ The goods recited in Applicant’s application include, *inter alia*, men’s, women’s and children’s swimwear including “bikinis.”

The dominant portion of Applicant's mark is the term "NAUTI." The dominant portion of the parties' respective marks are "NAUTI" and "NAUTICA" -- marks which look similar, which may be pronounced in a similar fashion, and which can share similar meanings and commercial impressions. As stated in *Uncle Ben's Inc. v. Stubenberg International Inc.*, 47 USPQ2d 1310, 1312 (TTAB 1998):

. . . while we must consider the marks in their entirety and may not improperly dissect them, we may give more weight in the likelihood-of-confusion analysis to the "dominant" elements. [Citing cases].

In comparing the marks as a whole, the Board must be mindful that where, as here, the goods are in large part identical, the degree of similarity necessary to find likelihood of confusion need not be as great. See, *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Real Estate One, Inc. v. Real Estate 100 Enterprises Corporation*, 212 USPQ 957, 959 (TTAB 1981); *ECI Division of E-Systems, Inc. v. Environmental Communications Incorporated*, 207 USPQ 443, 449 (TTAB 1980).

In assessing similarity of marks the test is not whether the parties' respective marks can be distinguished when subjected to a side-by-side comparison. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977). The proper emphasis is on the recollection of the average customer, who retains a general rather than specific impression of trademarks. See, *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992); *Winnebago Industries, Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

Given the fame of the NAUTICA mark, its market presence as a lifestyle brand, its use of different variations for particular types of Nautica products and/or particular lines of Nautica products and Nautica's use of a variety of other variations of its NAUTICA marks, including:

NJC NAUTI /// JEANS COMPANY

NAU TICA JEANS

NAU TIC AJE ANS

Nauti ^{jea}_{ca} ^s_{N-2} ^{comp}_{any}

NAU- TICA JNS CO

NAU TICA. EANS CO

N. AU. TI Co^A JNS

NAU. TI. CA

NAUT JEANS C

BE NAUTI

consumers are likely to perceive Applicant's mark as a variation of or a "designated line" of NAUTICA products and/or are likely to be confused, misled, or deceived that Applicant's goods are made by, licensed by, controlled by, sponsored by, or in some way connected, related or associated with Nautica.

Allowing registration of the application in issue will place a cloud on Nautica's right to use the root "nauti" in forms such as "BE NAUTI" (on boxer shorts) or in other variations of the NAUTICA Marks such as those shown above (e.g., as **Nauti** ^{jea}_{ca} ^s_{N-2} ^{comp}_{any} or **N. AU. TI Co^A JNS** or **NJC NAUTI /// JEANS COMPANY** or **NAUT JEANS C**), or as may be adopted in the future. If Nautica cannot use its NAUTICA Marks in variations such as those shown above in the normal course of marketing and branding its products, and if Nautica cannot enforce and protect its rights against others that seek, by use of similar marks, to draw an association with Nautica, the famous NAUTICA mark loses significance and becomes diluted.

Over the years, Nautica has focused enormous resources in policing and protecting its mark. Nautica has successfully opposed marks such as SPAUTICA, NAUTICALI, NAUTIGAL, NAUTICWEAR, NAUTIGIRL, NAUTI GEAR, NAUTI-CREW, NAUSICCAA, II NAUTI, NAUTICARD, NAUTIFISH, NAUTIC, and NAUTI BODY. See Opposer's 24th Notice of Reliance. Allowing the mark in issue in this proceeding would irreparably damage Nautica, confuse consumers, and dilute the distinctive quality of Nautica's Marks.

The fame of the NAUTICA mark and name require that Nautica be accorded a wide area of protection of its mark from both likelihood of confusion and from a likelihood of dilution.

2nd duPont Factor. The Similarity Or Dissimilarity and Nature Of The Parties' Respective Goods

9th duPont Factor. The Variety Of Goods On Which A Mark Is Or Is Not Used

The Board must assess the 2nd DuPont factor [i.e., the similarity of the goods] by comparing Applicant's goods as recited in its application, with Opposer's goods as recited in Opposer's registrations of record and also with Opposer's goods and services as actually used by Opposer in commerce. *See, Warnaco, Inc. v. Adventure Knits, Inc.*, 210 USPQ 307, 314-315 (TTAB1981).

The goods recited in the application in issue are²⁵:

IC 003. US 001 004 006 050 051 052. G & S: **Perfumes, colognes, and essential oils for personal use; deodorants and antiperspirants for personal use; cleaning preparations for personal hygiene purposes, namely, skin cleansers, facial cleansers, shower gels, shower wash, body scrubs, facial scrubs, and facial masks; hair care preparations, namely, hair shampoo, hair conditioner, styling gel, hair spray, hair cream, hair mousse; sunscreen cream and sun block preparations; shaving preparations, namely, non-medicated shaving balm, shaving cream, shaving foam, shaving gel, shaving lotion, shaving soap, after-shave gel, and after-shave lotion; cosmetics, namely, foundation and powder make-up, concealers, blush, eye**

²⁵ The goods highlighted in bold are goods identical to goods recited in Opposer's registrations of record. The remaining goods (i.e., un-highlighted) are also for the most part, goods sold by Opposer in commerce under Opposer's NAUTICA marks.

shadow, eyeliners, eyebrow pencils, mascara, lip gloss, lip liner, and lipstick; nail care preparations, namely, nail enamel, nail cream, and nail polish; **toiletries, namely bar and liquid skin soaps, body lotions, body cream, body powder**, hand cream, eye cream, and skin moisturizers.

IC 025. US 022 039. G & S: **Men, women and children's clothing, namely shirts, T-shirts, tank tops, jerseys, polo shirts, blouses, sweatshirts, shorts, pants, slacks, sweatpants, jeans, suits, blazers, coats, jackets, overalls, warm-up suits, skirts, dresses, hosiery, undershirts, underwear, boxer shorts, bras, sports bras, socks, belts, suspenders, hats, gloves, scarves, earmuffs, neckties, neckbands, armbands, headbands, sportswear, namely, shirts, shorts, pants, sweatshirts and jackets, sleepwear, nightgowns, pajamas, lingerie, and robes; footwear, namely, shoes, boots, sneakers, slippers, beach footwear, and sandals; swimwear, namely bathing trunks, bathing caps, beach wraps, bikinis, and bathing suits.**

Opposer's NAUTICA marks are used with a large variety of goods and services, including a wide variety of apparel in Class 25, and fragrances and cosmetics in Class 3. Many of the products listed in Nautica's registrations of record are identical to those recited in the above application in issue, e.g.:

Reg. No. 1557528 - NAUTICA for perfumes and essential oils for personal use; Reg. No. 1882757 - NAUTICA for shaving cream and toilet soap; Reg. No. 1464663 - NAUTICA for, *inter alia*, hosiery, shoes, undershirts, undershorts, shirts, blouses, jackets, pants, coats, suits, bathing suits, bathrobes, slippers and shorts; Reg. No. 1580007 - NAUTICA for belts and suspenders; Reg. No. 1523565 - NAUTICA and emblem design for, *inter alia*, hosiery, shoes, undershirts, undershorts, shirts, blouses, pants, jackets, coats, suits, bathing suits, bathrobes, slippers and shorts; Reg. No. 1862585 - NAUTICA for footwear; Reg. No. 2523102 - NAUTICA JEANS COMPANY for, *inter alia*, Men, women and children's wearing apparel, namely, hosiery, shoes, sneakers, boots, undershirts, boxer shorts, shirts, blouses, pants, jackets, coats, suits, bathing suits, bathrobes, slippers, shorts, ties, scarves, socks, hats, gloves, belts and suspenders; Reg. No. 2474154 - NAUTICA JEANS for, *inter alia*, Men, women and children's wearing apparel, namely, hosiery, shoes, sneakers, boots, undershirts, boxer shorts, shirts, blouses, pants, jackets, coats, suits, bathing suits, bathrobes, slippers, shorts, ties, scarves, socks, hats, gloves, belts and suspenders; Reg. No. 2697078 - NAUTEX for, *inter alia*, jackets and coats; Reg. No. 2993023 - NAUTICA BLUE for, *inter alia*, Men's, women's and children's wearing apparel, namely, hosiery, shoes, sneaker, boots, undershirts, boxer shirts, shirts, blouses, pants, jackets, coats, suits, bathing suits, bathrobes, slippers, shorts, ties, neckwear, scarves, socks, hats,

gloves, belts and suspenders; Reg. No. 2987139 - NAUTICA BLUE for men's, women' and children's wearing apparel, namely, undershirts, t-shirts, shirts, blouses, pants, shorts, bathing suits and swimwear; Reg. No. 3109967 - NAUTICA BEACH for, *inter alia*, men's, women's and children's bathing suits, swim trunks, swim suits, shorts, pants, warm-up suits, sweat shirts and pants and bathing caps; Reg. No. 3076597 - NAUTICA COMPETITION for, *inter alia*, cosmetics and toiletries for men and women, namely, colognes, skin cleansers, shaving cream, after-shave lotion, toilet soap, personal deodorants, talcum powder, skin creams and lotions, shampoo and conditioner; Reg. No. 3076796 - NAUTICA COMPETITION for, *inter alia*, Men's, women's and children's wearing apparel, namely, shoes, sneakers, boots, undershirts, shirts, pants, jackets, coats, bathing suits, bathrobes, pajamas, slippers, shorts, ties, socks, hats, gloves; Reg. No. 3170055 - NAUTICA BLUE for perfumery and after shave lotions; Reg. No. 3170094 - NAUTICA VOYAGE for perfumery and after shave lotions; Reg. No. 3272760 - NAUTICA GOLF for, *inter alia*, shirts, jackets, pants, hats, shorts and polo shirts.

The fact that the NAUTICA mark has become a famous and well-recognized life-style brand used on a broad range of goods makes the mark “strong” according Nautica a wide berth of protection. *Recot Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000). The fact that many of the parties’ respective goods are “identical” makes it that much more likely that consumers will be confused. *See, Century 21 Real Estate Corp. v. Century Life of America*, 23 USPQ2d 1698, 1700, 1701 (CA FC 1992) (“When marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines.”).

The parties Class 3 and Class 25 goods are almost entirely identical and Applicant’s goods are otherwise related and/or complementary.

This major duPont factor entirely and unequivocally favors Opposer.

**3rd duPont Factor. The Similarity or Dissimilarity Of
Established, Likely-To-Continue Trade Channels**

It is established rule that where goods are recited in an application or registration without any restriction as to classes of purchasers or trade channels, the following legal presumptions

apply: (1) that the description encompasses all goods or types of goods embraced by the broad terminology; (2) that the goods move through all of the channels of trade suitable for goods of that type; and (3) that they reach all potential users or customers for such goods. *See, Warnaco, supra*, at 210 USPQ 314-315; and *Guardian Products Co., Inc. v. Scott Paper Co.*, 200 USPQ 738, 741 (TTAB 1978). There are no limitations or restrictions recited in the application in issue. Accordingly, the Board must find, as a matter of law, that Applicant's goods which are identical, and nearly identical and/or highly related and complimentary to Opposer's goods must be presumed to be marketed in the same and/or similar channels of trade and to the same class of consumer. *See also, Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003).

Nautica's goods, including its class 25 and class 3 goods, are sold through customary channels of trade suitable to such goods, including without limitation department stores. Because of the identical nature of the goods in issue in this case, the Applicant's goods must be presumed to move through the same channels and presumed to reach all potential users or customers for such goods.

This major duPont factor entirely and unequivocally favors Opposer.

4th duPont Factor. The Conditions Under Which And Buyers To Whom Sales Are Made (Impulse vs. Careful, Sophisticated Purchasing)

The application in issue is an "Intent to Use" application and there is no evidence of record of use of the mark by the Applicant. Further, there is no evidence of record as to the intended pricing of the goods recited in the application in issue. Many of the goods in said application, including the goods that are legally identical to those of Opposer, are not limited in any way as to class of consumer. In fact, the Applicant's Class 25 goods are preceded by the phrase: "Men, women and children's clothing, namely . . .".

The Board must find that Applicant's goods and Opposer's goods are provided under any and all marketing conditions applicable to the recited goods, and under any price points (including upper-level price points) applicable to such goods, and are provided to and purchased by all classes of consumers appropriate to the goods identified. *See, Guardian Products, supra*; and *Genesco, supra*.

This duPont factor favors Opposer.

**5th duPont Factor. The Fame Of Opposer's Marks
(Sales, Advertising, Length Of Use)**

The fame of a mark "plays a dominant role in cases featuring a famous or strong mark." *See, Kenner Parker Toys Inc. v. Rose Arts Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). Famous marks are accorded more protection because they are more likely to be remembered and associated in the public mind than a weaker mark. *Id.* "[A] strong mark . . . casts a long shadow which competitors must avoid." *Id.*

"Fame" is a dominant factor in likelihood of confusion analysis. *See, Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin*, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005) ("Fame of an opposer's mark, if it exists, plays a dominant role in the process of balancing the *DuPont* factors," citing *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1327, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000).

In fact, it is error to discount the import of a "famous" mark. *Id.*, at 1456. *See also, Specialty Brands v. Coffee Bean Distribs.*, 748 F.2d 669, 671, 223 USPQ 1281, 1282 (Fed. Cir. 1984).

As stated in *Kenner v. Rose Art.*, *supra*, 22 USPQ2d at 1456:

Thus the Lanham Act's tolerance for similarity between competing marks varies inversely with the fame of the prior mark. As a mark's fame

increases, the Act's tolerance for similarities in competing marks falls. . . . The driving designs and origins of the Lanham Act demand the standard consistently applied by this court – namely, more protection against confusion for famous marks.

As presented above in the “Factual Background” section of this brief (pp. 4-6), Nautica's NAUTICA Mark meets all the criteria for being “famous,” both for purposes of likelihood of confusion analysis and dilution analysis. The following is a summary of the evidence of fame of the NAUTICA mark. --

- Continuous use of the mark NAUTICA on clothing since 1983 and continuous use on fragrances since 1987.
- Since 2004, Nautica has had the second largest market share for men's wear in the United States (just behind Ralph Lauren)²⁶.
- Over the past 7 years Nautica's wholesale sales averaged over \$900 million annually (approximately \$1.8 billion per year at retail)²⁷.
- Nautica products are sold at over 2,400 name retail stores in the U.S. (including, by way of example, such famous retailers as Macy's, Bloomingdales, Dillard's, Lord & Taylor, Belk, Bed Bath & Beyond, etc.) and in many cases via store-within-a-store areas in said retail stores, also through 121 Nautica free-standing stores, and over the Internet²⁸.
- Nautica owns numerous U.S. trademark registrations for NAUTICA and variations thereof in numerous classes (primarily in Class 25 and Class 3, but also in Classes 6, 8, 9, 11, 12, 14, 16, 18, 20, 21, 24, 26, 28, 35, 36, and 41)²⁹.
- NAUTICA has become a “life-style brand”, marketing men's, women's and children's apparel and sportswear; fragrances and cosmetics; eyeglasses, sunglasses and related accessories; watches and clocks; diaries, wallets, and luggage; furniture; and housewares and tableware, and many others³⁰.

²⁶ Test. Bizzari, pp. 51-52 (NPD Marketing Research)

²⁷ Test. Bizzari, pp. 50-51 and Ex. “J” thereto.

²⁸ Test. Bizzari, pp. 26-30 and 81.

²⁹ Test. Bizzari, pp. __ and Ex. “B” thereto; and Opposer's 1st Notice of Reliance.

³⁰ Test. Bizzari, pp. 8-14.

- Nautica’s advertising and promotional costs over the past 8 years have averaged over \$37 million annually.
- Nautica advertises through major TV networks (e.g., ABC, NBC, CBS, Fox, etc.) on well-known, nationally broadcast television shows (e.g., *60 Minutes*, *Without a Trace*, *Everybody Loves Raymond*, *Wheel of Fortune*, *Grey’s Anatomy*, *The Daily Show with Jon Stewart*, *Comedy Central*, etc.)³¹.
- Nautica advertises in major U.S./International publications, including by way of example only, *Cosmopolitan*, *Vogue*, *Sports Illustrated*, “O” (Oprah), *House & Garden*, *GQ*, *Elle*, *Rolling Stone*, etc.³² with circulation averaging over 200 million per year and generating over a billion impressions per year³³.
- Nautica promotes itself and its products through sponsorship of famous sporting events, music events, charitable events, and the like, including, *inter alia*, the “Nautica Malibu Triathlon,” the “Subaru Gorge Games,” the “Legg Mason Tennis Classic,” the “Starlight Foundation,” the “AVP” volley ball tour, the “Newport Jazz Festival,” the “US Sailing Team,” numerous regattas, the “Nautica/GQ kayak for a Cause,” the “NYC Triathlon,” and many others³⁴. Sponsored athletes wear Nautica clothing, sail boats/kayaks say “NAUTICA,” the sails say “NAUTICA,” the event tents, flags and signage say “NAUTICA,” and promotional goods (e.g., t-shirts) and samples (e.g., fragrance) say “NAUTICA.”³⁵ Nautica’s sponsorship activities alone generate multiple billions of consumer impressions annually³⁶.
- Nautica’s print advertising, television advertising and sponsorships generate multiple billions of consumer impressions annually.³⁷
- Nautica has received substantial unsolicited media attention referencing the fame and renown of the NAUTICA mark and name. See, Nautica’s Notices of Reliance, Nos. 2-23 (articles from 1992-2008). A representative sampling of excerpts (i.e., two from each year from 1992 to 2007) follows:

³¹ Test. Bizzari, p. 38, and Ex. “H” thereto

³² Test. Bizzari, pp. 39-40, and Ex. “H” thereto

³³ Test. Bizzari, p. 42, and Ex. “H” thereto

³⁴ Test. Bizzari, pp. 44-50, and Ex. “I” thereto

³⁵ Test. Bizzari, pp. 44-46.

³⁶ Test. Bizzari pp. 48-49 and Ex. “H” thereto

³⁷ Test. Bizzari, pp. 41-42 and 48-49, and Ex. “H” thereto

Chicago Tribune 4/15/92: "Such names as Ralph Lauren, Gant, Mark Cross, Nautica and Louis Vuitton."

St. Louis Post-Dispatch 10/18/92: Referring to the "Nautica and Tommy Hilfiger lines" as "ubiquitous."

Forbes 7/19/93: "Tried and true labels such as Liz Claiborne, Carole Little, Tommy Hilfiger, Ralph Lauren and Nautica."

The Atlanta Journal and Constitution 3/21/1993: "... in the big leagues with Ralph Lauren, Tommy Hilfiger and Nautica."

Chicago Sun-Times 8/3/94: "Who's Who in menswear . . Donna Karan, Joseph Abboud, Alexander Julian, Jhane Barnes, Tommy Hilfiger, Nautica's David Chu."

The Washington Post 11/25/94: "This year, everybody's wearing Polo, Nautica and Tommy Hilfiger."

Harper's Magazine 11/95: "[A]ll the great and glorious names in the retail merchant's Hall of Fame, not only Armani and Ferragamo but also Tommy Hilfiger, Clinique, Ralph Lauren, Versace, Piaget, Nautica, Valentino, and Donna Karan."

Providence Journal-Bulletin 8/13/1995: "Nautica International, a leading men's-wear company, has joined forces with Sailing World magazine in Newport as national sponsors of the regatta series."

The Tampa Tribune 6/15/96: "The blockbusters [fragrances] are Polo Sport, Tommy by Tommy Hilfiger, Hugo Boss, Nautica, Davidoff Cool Water, CK One."

The Virginian Pilot 7/26/96: "Calvin Klein, Boss, Nautica and Tommy Hilfiger . . . are among the best selling name-brand jeans."

The Boston Herald 9/8/96: "... the importance of labels . . Strictly Nikes, Nautica shirts, Levis or Ralph Lauren jeans"

The Seattle Times 3/13/97: "... megabrands such as Ralph Lauren and Nautica."

Crain's New York Business 5/5/97: "Today, labels like Nautica and Tommy Hilfiger command prominent display space in department stores."

WWD 5/14/98: “Meanwhile, at NationsBanc Montgomery Securities, Susan B. Silverstein has been touting what she calls ‘Men’s Wear’s Triple Crown’: Tommy Hilfiger, Nautica Enterprises and Polo Ralph Lauren.”

The Virginian-Pilot 6/21/1998: “‘This is an ultra-modern Belk store,’ said store manager, Kenneth Jarmon, listing famous names such as Nautica and Chaps, Tommy Hilfiger, Liz Claiborne and Jantzen.”

Columbus Dispatch 2/16/99: “The mega-successful and popular Nautica line.”

The New York Post 11/28/99: “Superstars like Nautica, Tommy and Polo Sport monopolizing the limelight.”

Daily News Record 9/15/2000: Chu [Nautica CEO] is getting used to having his clothes on actors: the casts of two new shows – Aaron Spelling’s *Titans* and Darren Star’s *Grosse Pointe* – will wear Nautica apparel.”

Tampa Tribune 9/23/2000: “THE EXCHANGE SERVICE sells famous labels such as Nautica and Chaps.”

Daily News Record 9/24/2001: “The major national brands are represented here, including the three big collections – Tommy Hilfiger, Nautica and Polo”

Sun-Sentinel 5/2/2002: “The sportswear apparel giant Nautica has become the official sunglass outfitter of the Stars & Stripes crew who are hoping to bring the America’s Cup home.”

Home Textiles Today 7/29/2002: “At the Linens ‘n Things location . . . Nautica dominates the section as the lead brand.”

WWD 1/10/2003: “Leading [fragrance] sellers included Calvin Klein, Nautica and Ralph Lauren brands.”

Ottawa Citizen 11/15/2003: “. . . leading [lingerie] fashion brands such as Chaps Ralph Lauren, Calvin Klein, Nautica and Speedo.”

HFN 12/15/2003: “The only textiles brands that mean anything are Ralph Lauren, Tommy Hilfiger and Nautica.”

Charlotte Observer 1/21/2004: “more and more parents are naming their children after consumer products, names like Armani, Nautica and Camry.”

Chicago Tribune 5/29/2004: “At Nautica, also one of the nation’s top three brands.”

CNNMoney.com 7/25/2005: “Apparel giants such as Dockers, Nautica, and Nine West.”

The Salt Lake Tribune 11/25/2005: “Major . . . retailers: Nike Factory Store, Calvin Klein, Nautica, Geoffrey Beene, Polo Ralph Lauren, Tommy Hilfiger.”

WWD 7/26/2006: Swimwear Rankings: Nautica ranked no. 2 after Speedo.

The Boston Globe 6/13/2007 “Sponsors [of the AVP Pro Volleyball Tour] include McDonald’s, Nautica, Anheuser-Busch, Nature Valley Granola Bars, and Microsoft’s Xbox.”

The New York Post 7/22/2007: “All this is not lost on major corporate sponsors, such as Nautica and Toyota.”

This duPont factor [Fame] entirely and unequivocally favors Nautica.

**6th duPont Factor. The Number and Nature of Similar
Marks In Use on Similar Goods**

There is no evidence of any third party use of the term NAUTICA or variations of the same on clothing, fragrances, or cosmetics. Accordingly, for purposes of this proceeding, Nautica’s mark must be considered to be “strong.” Further in that regard, Nautica has consistently and vigilantly policed its mark over the years, having successfully opposed marks such as SPAUTICA, NAUTICALI, NAUTI-GAL, NAUTICWEAR, NAUTIGIRL, NAUTI GEAR, NAUTI-CREW, NAUSICCAA, II NAUTI, NAUTICARD, NAUTIFISH, NAUTIC, and NAUTI BODY. See, Nautica’s 24th Notice of Reliance – summary of proceedings and copies of decisions.

This duPont factor entirely favors Nautica.

7th duPont Factor. **The Nature And Extent Of Any Actual Confusion; and**
8th duPont Factor. **The Length of Time During And Conditions Under**
 Which There Has Been Concurrent Use Without
 Evidence Of Actual Confusion

The application in issue is an “Intent to Use” application and there is no evidence of record of use of the opposed mark by the Applicant. Accordingly, for purposes of this proceeding, duPont factors 7 and 8 are not relevant.

10th duPont Factor. **Market Interface Between The Parties**

The Applicant’s application and any use by Applicant of its mark is without the consent or permission of Nautica. See Notice of Opposition, ¶14. There are no agreements or understandings between the parties to the contrary.

Accordingly, this duPont factor entirely favors Nautica.

11th duPont Factor. **The Extent To Which Opposer Has A Right**
 To Exclude Others From Use Of Its Marks

The dominant portion of the parties’ respective marks are similar in look, sound, meaning and commercial impression. The parties’ respective goods are, in large part, identical.

Nautica is the owner of numerous “incontestable” registrations of record, including Reg. No. 1464663 for NAUTICA in Class 25 registered since November 1987 and Reg. No. 1557528 for NAUTICA in Class 3 registered since September 1989. Nautica is entitled to all the presumptions that flow from such ownership, including the right to exclude others from use of the same or confusingly similar mark on the same or related goods. See 15 U.S.C. §§ 1057(b), 1115(a), and 1115(b). With regard to Nautica’s incontestable registrations, its registrations are “conclusive” evidence of its rights.

Nautica is also entitled to the factual presumptions that the parties' channels of trade overlap, and that the ultimate consumers overlap. Nautica has shown that its NAUTICA Mark is famous.

Further, Nautica has consistently and vigilantly policed its mark over the years. See, Nautica's 24th Notice of Reliance – summary of proceedings and copies of decisions.

This duPont factor entirely favors Opposer.

12th duPont Factor. The Extent Of Potential Confusion Is Substantial

When one considers the evidence of record, namely, (1) The fact that the dominant portion of the parties' respective marks are similar; (2) the identical nature of the parties' respective goods; (3) the fame associated with Nautica's mark and name; (4) the fact that by law the channels of trade and ultimate consumers necessarily overlap; and (5) Nautica's numerous registrations of record, the Board should grant judgment in favor of Nautica..

As has often been stated, there is "no excuse for even approaching the well-known trademark of a competitor . . . and that all doubt as to whether confusion, mistake, or deception is likely is to be resolved against the newcomer, especially where the established mark is one which is famous." *Nina Ricci S.A.R.L. v. E.T.F. Enterprises Inc.*, 889 F.2d 1070, 12 USPQ2d 1091 (Fed. Cir. 1989), quoting *Planter's Nut & Chocolate Co. v. Crown Nut Co., Inc.*, 305 F.2d 916, 134 USPQ 504, 511 (CCPA 1962). See also, *Century 21 Real Estate Corp. v. Century Life of America*, 23 USPQ2d 1698, 1701 (CAFC 1992) (and cases cited therein).

IV. ARGUMENT (LIKELIHOOD OF DILUTION)

As addressed above (i.e, pp. 21-26, 5th duPont Factor), Opposer's mark is well-known and famous. For purposes of dilution, a mark is considered "famous" pursuant to 15 USC §1125(c)(2)(A) (Trademark Dilution Revision Act of 2006), if:

. . . it is recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark's owner" and considering certain relevant factors, including:

- (i) the duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties.
- (ii) The amount, volume, and geographic extent of sales of goods or services offered under the mark.
- (iii) The extent of actual recognition of the mark.
- (iv) Whether the mark [is] registered . . . on the principal register.

Rather than reiterate the relevant facts, the Board is referred to the "Factual Background" section at pp. 4-6 above and the summary of evidence of fame at pp. 21-26 above. The same are clear and convincing evidence of the fame of Opposer's NAUTICA Mark for purposes of a dilution claim under 15 USC §1125(c)(2)(A).

"Dilution by blurring" is defined in 15 USC §1125(c)(2)(B) (Trademark Dilution Revision Act of 2006) by reference to various relevant factors, including the following:

- (i) The degree of similarity between the mark or tradename and the famous mark.
- (ii) The degree of inherent or acquired distinctiveness of the famous mark.
- (iii) The extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark.
- (iv) The degree of recognition of the famous mark.

- (v) Whether the user of the mark or trade name intended to create an association with the famous mark.
- (vi) Any actual association between the mark or trade name and the famous mark.

Regarding the above factors, (1) the marks are similar (see above at pp. 8-16 – 1st duPont Factor section); (2) the NAUTICA Mark has acquired extraordinary secondary meaning (see above at 4-6 and 21-26 – Factual Background section and 5th duPont Factor section); (3) Nautica’s use of its marks has been substantially exclusive (see above at p. 25 – 6th duPont Factor section) and Nautica has consistently and vigilantly policed its mark over the years (See, Nautica’s 24th Notice of Reliance – summary of proceedings and copies of decisions); (4) the NAUTICA Mark is recognized by consumers throughout the United States as one of the top/premier clothing and fragrance brands and has had the second largest U.S. market share in men’s wear for the past five years (see above at 4-6 and 21-26 – Factual Background section and 5th duPont Factor section); (5) the Applicant has alleged that its use of NAUTI really means “naughty,” however the Applicant’s intent and conscious choice was to use the term NAUTI thus creating the appearance of an association with Nautica. Given the fame of Nautica’s marks, Applicant has “no excuse for even approaching the well-known trademark of Nautica. *Nina Ricci S.A.R.L.*, *supra*, 12 USPQ2d 1091 (Fed. Cir. 1989).

Opposer has submitted clear and convincing evidence concerning the “fame” of its mark and name and of dilution by blurring.

V. CONCLUSION

As oft said, there is “no excuse for even approaching the well-known trademark of a competitor . . . and all doubt as to whether confusion, mistake, or deception is likely is to be

resolved against the newcomer, especially where the established mark is one which is famous.”

Nina Ricci S.A.R.L. v. E.T.F. Enterprises Inc., 889 F.2d 1070, 12 USPQ2d 1091, 1094 (Fed. Cir. 1989), quoting *Planter’s Nut & Chocolate Co. v. Crown Nut Co. Inc.*, 305 F.2d 916, 134 USPQ 504, 511 (CCPA 1962).

In summary, and quoting the Board in its decision on Opp. No. 91165909 (unreported) at pp.34-35:

The dominant factor in this case is the fame of opposer’s NAUTICA marks. Because opposer has established that its NAUTICA marks are entitled to a high degree of public recognition and renown, they are more likely to be remembered and associated in consumers’ minds than weaker marks and accorded more protection. In addition, to the high degree of public recognition and renown, applicant’s mark is proposed for use in connection with goods which are identical in part to the goods in opposer’s registrations. Therefore it is more likely that consumers will be confused when purchasing applicant’s products when applicants’ products are identified by a mark that is similar to opposer’s famous marks. *Recot Inc. v. M.C. Bacton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000). In reaching this decision, we note that there is “no excuse for even approaching the well-known trademark of a competitor . . . and that all doubt as to whether confusion, mistake, or deception is likely is to be resolved against the newcomer, especially where the established mark is one which is famous.” *Nina Ricci S.A.R.L. v. E.T.F. Enterprises Inc.*, 889 F.2d 1070, 12 USPQ2d 1091, 1094 (Fed. Cir. 1989), quoting *Planter’s Nut & Chocolate Co. v. Crown Nut Co. Inc.*, 305 F.2d 916, 134 USPQ 504, 511 (CCPA 1962).

Respectfully submitted,

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By: John M. Rannells

Certificate of Service

I hereby certify that a true and complete copy of the foregoing Opposer's Trial Brief has been served on counsel for Applicant by mailing said copy on May 26, 2009, via First Class Mail, postage prepaid to:

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